IN THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 98-1490

PUBLICATIONS INTERNATIONAL, LTD.,

Plaintiff-Appellant,

v.

LANDOLL, INC.,

Defendant-Appellee.

Appeal from the United States District Court
for the Northern District of Illinois, Eastern Division.
No. 96 C 5180—**David H. Coar**, *Judge.*

ARGUED NOVEMBER 5, 1998—DECIDED DECEMBER 16, 1998

Before POSNER, *Chief Judge*, and FLAUM and MANION, *Circuit Judges.*

POSNER, *Chief Judge.* Both parties, PIL and Landoll, are publishers of cookbooks and children's books. PIL, the plaintiff, contends that its books have a distinctive "trade dress" which Landoll has copied in violation of section 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125(a)(1), and of parallel state statutes unnecessary to discuss separately. The district judge granted summary judgment for Landoll.

The term "trade dress" refers to the appearance of a product when that appearance is used to identify the producer. To function as an identifier, the appearance must be distinctive by reason of the shape or color or

texture or other visible or otherwise palpable feature of the product or its packaging. If it isn't distinctive, it won't be associated in the mind of the consumer with a specific producer. If it is distinctive, and if as a result it comes to identify the producer, the danger arises that the duplication of this appearance, this "trade dress," by a competing seller will confuse the consumer regarding the origin of the product; the consumer may think it the product of the producer whose trade dress was copied. Trade dress thus serves the same function as trademark, and is treated the same way by the Lanham Act and the cases interpreting it. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992); *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986); 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8:1, pp. 8-3 to 8-4 (4th ed. 1998).

The courts have struggled to articulate a standard for when a trade dress is sufficiently distinctive to be entitled to the prima facie protection of the Lanham Act. See, e.g., *Dunn v. Gull*, 990 F.2d 348, 351 (7th Cir. 1993); *Insty*Bit, Inc. v. Poly-Tech Industries, Inc.*, 95 F.3d 663, 672 (8th Cir. 1996); *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1448-51 (3d Cir. 1994); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008-09 (2d Cir. 1995); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). This struggle is mirrored in the district judge's opinion and in the briefs of the parties. But efforts to define intuitive concepts such as "distinctiveness" are often both futile and unnecessary. We use with perfect clarity many words that we can't define, such as "time," "number," "beauty," and "law." Everyone can recognize when a product has a "distinctive" appearance, without having been tutored in the meaning of "distinctiveness." But "beyond stating the principles to be applied there is little to be said except to compare the impression made by the two" trade dresses. *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 30

(1919) (Holmes, J.). So let us consider what is at stake in the decision. On the one hand, a seller should be encouraged to make his products recognizable by consumers at a glance as *his* product and not that of another seller. This way the seller will be able to appropriate the benefits of making a product that consumers like, and so he will have an incentive to make a good product. Other sellers won't be able to free ride on his efforts by tricking the consumer into buying an inferior product from them in the belief that it is the product of the seller whom they have grounds to trust.

On the other hand, a seller should not be allowed to obtain in the name of trade dress a monopoly over the elements of a product's appearance that either are not associated with a particular producer or that have value to consumers that is independent of identification. In the lingo of unfair competition, elements of the latter type—elements whose value is not merely signification—are a product's "functional" features; they can be either utilitarian in the narrow sense of that word, or aesthetic. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 164-65 (1995); *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 297-98 (7th Cir. 1998); *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 338-40, 343 (7th Cir. 1985). Wine is sold corked. The cork is a functional feature of the product, because it enables the wine to age properly; and so the first seller of wine could not claim that the cork was his trade dress. Mink coats are normally sold dyed. The dye does not make the coat any warmer, but it makes it more beautiful, and, once again, it could not be claimed as trade dress by the first furrier to have hit on the idea. Functional improvements may be patentable, or protected as trade secrets, but they cannot be appropriated in the name of trade dress even if they are distinctive.

It would be arbitrary as well as puritanical and even philistine to deny that one function of modern consumer packaging is to be beautiful, the motivation being some-

times a hope that the consumer will infer the quality of the product from the beauty of the package and sometimes a hope that the consumer will derive utility (and so be willing to pay more) from the packaging directly, as when a consumer displays a shapely bottle of champagne to his dinner guests. A producer cannot in the name of trade dress prevent his competitors from making their products as visually entrancing as his own. Ordinarily there is a sufficient variety of pleasing shapes, sizes, colors, and ornamentation to enable beauty without sacrificing differentiation. But if consumers derive a value from the fact that a product looks a certain way that is distinct from the value of knowing at a glance who made it, then it is a nonappropriable feature of the product.

So there cannot be an objection in principle to the concept of aesthetic functionality as a limitation on the legal protection of trade dress. And notice how the "utilitarian" and the "aesthetic" merge in the case put earlier of corking. The cork improves the taste of the wine; the dye enhances the beauty of the mink coat; taste is akin to beauty. But the critics who argue that in application the concept is mischievously vague certainly have a point, see, e.g., 1 McCarthy, *supra*, §§ 7:80, 7:81, though not one necessary to labor further here.

Formally, distinctiveness and functionality are separate issues. While the burden of proving distinctiveness is of course on the plaintiff, some courts, including our own, hold that functionality is an affirmative defense and so the burden of proof rests on the defendant. E.g., *Thomas & Betts Corp. v. Panduit Corp.*, *supra*, 138 F.3d at 297; *Knitwaves, Inc. v. Lollytogs Ltd.*, *supra*, 71 F.3d at 1006. Other courts place the burden on the plaintiff. E.g., *Versa Products Co. v. Bifold Co.*, 50 F.3d 189, 199 (3d Cir. 1995); *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 869 (8th Cir. 1994). Others have passed. E.g., *Tools USA & Equipment Co. v. Champ Frame Straightening, Inc.*, 87 F.3d 654, 657 n. 2 (4th Cir. 1996); *Tec Engineering Corp. v. Budget Molders*

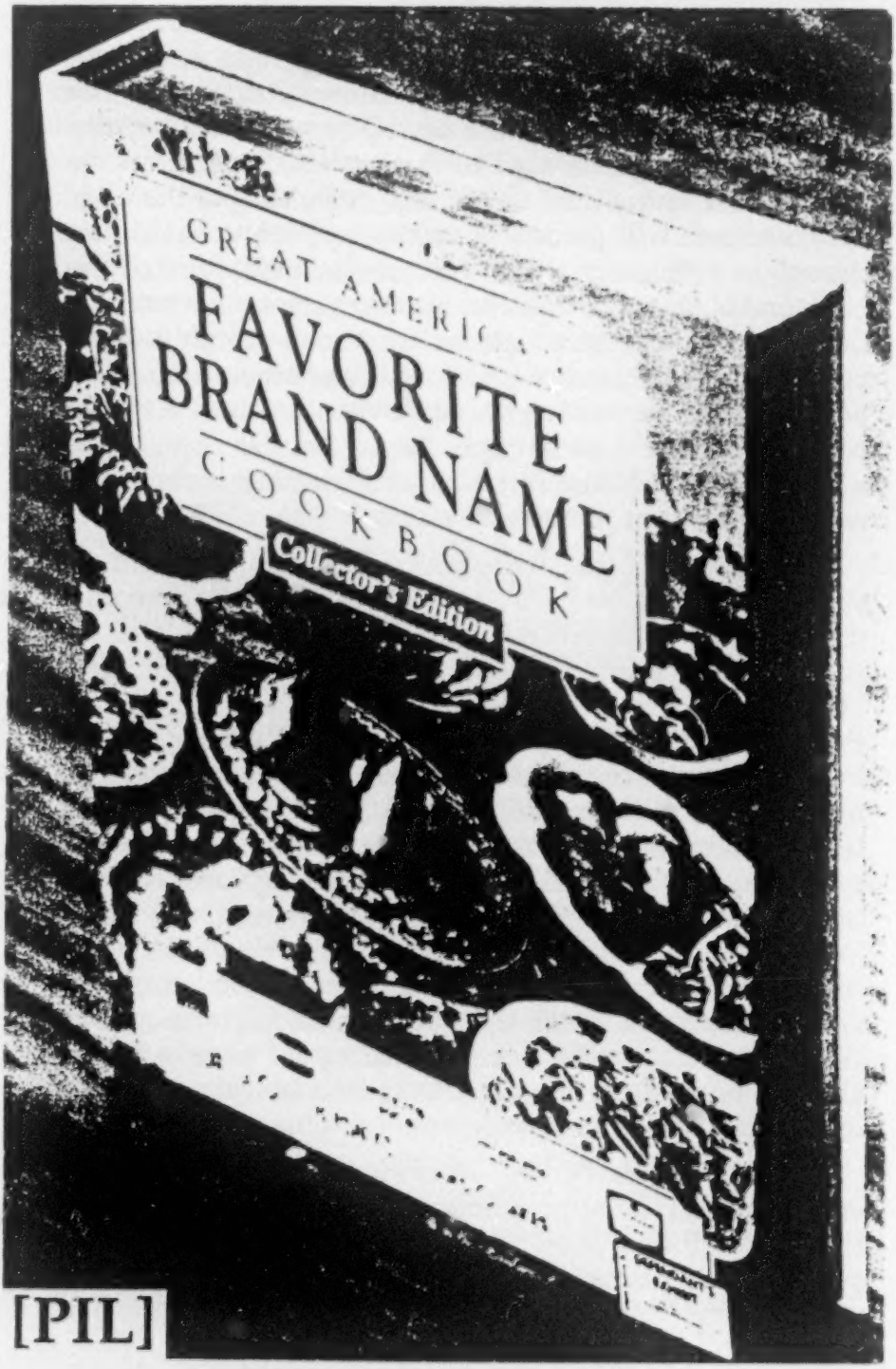
Supply, Inc., 82 F.3d 542, 546 n. 3 (1st Cir. 1996). The uncertainty is limited to unregistered trademarks or trade dress (PIL's trade dress is unregistered); registration creates a presumption of validity, implying that the defendant has the laboring oar on all issues relating to validity, including functionality, as held in *Aromatique, Inc. v. Gold Seal, Inc.*, *supra*, 28 F.3d at 869.

Very little turns on resolving the circuit conflict, both because evidence of functionality is equally available to both parties and because functionality and distinctiveness are intertwined issues. Functional features are by definition those likely to be shared by different producers of the same product and therefore are unlikely to identify a particular producer. The principal exception is for new products. If a product is truly new, its functional features may be new too and so may help distinguish it from other products and thus identify the producer. Nevertheless, these features cannot be appropriated; otherwise, competitors would be prevented from duplicating the new product even to the extent permitted by the branches of the law of intellectual property that protect innovation rather than designations of source. The first producer of an automobile designed a product that had a distinctive appearance; but if its distinctiveness was due to the fact that it had an engine in front instead of horses, and a crank, radiator grill, and steering wheel, the producer would not be able to claim that this combination of functional features constituted trade dress; for that would give him a monopoly of the production of automobiles, and trademark law is not intended to confer product monopolies. *W.T. Rogers Co. v. Keene*, *supra*, 778 F.2d at 339.

There isn't much more to be said at the level of doctrine about the issue in this case, except that a grant of summary judgment on the basis either that the plaintiff's trade dress is not distinctive or that its distinctiveness rests on functional features of the dress is proper only if no reasonable trier of fact could conclude otherwise. See,

e.g., *Thomas & Betts Corp. v. Panduit Corp., supra,* 138 F.3d at 297-300; *Sands, Taylor & Wood Co. v. Quaker Oats Co.,* 978 F.2d 947, 952 (7th Cir. 1992); *OddzOn Products, Inc. v. Just Toys, Inc.,* 122 F.3d 1396, 1408 (Fed. Cir. 1997). For while it is true that distinctiveness is not really an issue of fact, but rather an issue of the application of a legal standard to facts, it is classified with issues of fact for purposes of drawing the line between the jury's authority and that of the judge and the reviewing court. *Disc Golf Ass'n, Inc. v. Champion Discs, Inc.,* 158 F.3d 1002, 1006 (9th Cir. 1998); *Pebble Beach Co. v. Tour 181 Ltd.,* 155 F.3d 526, 537 (5th Cir. 1998); *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.,* 111 F.3d 993, 1001-02 (2d Cir. 1997); *Epic Metals Corp. v. Souliere,* 99 F.3d 1034, 1037 (11th Cir. 1996); cf. *Mucha v. King,* 792 F.2d 602, 604-06 (7th Cir. 1986).

The trade dress of PIL's cookbooks is illustrated in the photograph (unfortunately not in color) that we have captioned "PIL." The components of the trade dress are the size of the pages (8½ inches by 11 inches), the gilded edges of the pages, and the covers, which are oilcloth or the equivalent. Each of these features is functional. The size of the pages is a convenience to the cook, who will usually want to lay the book flat on the kitchen counter (and that's easier to do if the book is large) and glance at it while cooking, which is easier to do if the print is large—and the larger the print, the larger the page must be if the total number of pages is not to be excessive. When the book is open, moreover, the recipe is on one page and a photograph of the dish that faithful compliance with the recipe is supposed to produce occupies the entire facing page. The larger the page and so the larger the picture, the more inviting the dish looks and so the more likely the reader is to try the recipe. The oilcloth cover makes it easier to keep the book clean, which is an issue with


GREAT AMERIC
FAVORITE
BRAND NAME
COOKBOOK
Collector's Edition

[PIL]

cookbooks because they are quite likely to get spattered in the course of cooking. And the gilded pages are necessary to prevent the unsightly appearance that printers call "bleeding." If a color picture on a page runs all the way to the page's edge, then when the book is closed, the side opposite the spine (that is, the side consisting of the ends of the pages) will present a motley appearance. Gilding the edges eliminates the differences in the colors of the page ends. Aesthetic considerations are not alien to book design. Although the adage is that you shouldn't judge a book by its cover, many people do this; otherwise, many books would be sold without covers, as used to be a common practice in Europe. Some people buy books mainly as wall decoration, and bookbinding is regarded as an art and not just as a trade.

What is true is that the problem of bleeding could be solved by giving the ends of the pages any uniform color; it needn't be gold. But the color gold on a product or its package is a prime example of aesthetic functionality. This is the case mentioned in *Qualitex Co. v. Jacobson Products Co, supra*, 514 U.S. at 165, where "color plays an important role (unrelated to source identification) in making a product more desirable." Gold connotes opulence, and so is a standard element of the décor of food products, such as chocolate, that are valued for their rich taste rather than for their nutritional value. It also has a long history of use in bookbinding; the spine of the book in which this opinion is printed is decorated with gilt. Gold is a natural color to use on a fancy cookbook. A different color on PIL's page ends would have a better claim to be a source signifier; compare a blue container of orange juice with an orange one.

Although none of the functional features of PIL's cookbooks can be appropriated to serve as a trade dress, it doesn't follow that the ensemble cannot be. Any product, any package, can be decomposed into elements

that are not protectable. *August Storck K.G. v. Nabisco, Inc.*, 59 F.3d 616, 620 (7th Cir. 1995). Every distinctive appearance is built up from elements that are not themselves distinctive: an Aubrey Beardsley drawing, for example, is built up of line segments. Cf. *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989). In the case of a consumer product, the elements might all be functional. If the product nevertheless presented a distinctive appearance, that appearance would be eligible for legal protection as trade dress unless it was the only way the product *could* look, consistent with its performing each of the product's functions optimally. E.g., *Service Ideas Inc. v. Traex Corp.*, 846 F.2d 1118, 1123 (7th Cir. 1988); *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1143 (3d Cir. 1986); *LeSportsac, Inc. v. K-Mart Corp.*, 754 F.2d 71, 76-78 (2d Cir. 1985). But obviously the fact that a competitor's product has the same functional features as the plaintiff's isn't going to make the latter distinctive; if it didn't have the same functional features, it might not be the same product.

Every producer of a cookbook has to worry about the cover getting spattered, the cook having difficulty laying the book flat and reading small print from a distance, the photos of the food dishes being too small to entice and inspire, the book as a whole looking cheap, and the pages (when the book is viewed from the side opposite the spine) presenting a ragged appearance because the color pictures that fill them bleed to the end of the page. Because of these concerns that are common to all publishers of fancy cookbooks, it is not surprising that more than one publisher would find it optimal, wholly apart from any desire to confuse consumers about the publisher's identity, to use the very combination of features that PIL claims compose its trade dress—large pages, an oilcloth cover, gilded page edges. Cookbooks published by different publishers will look rather alike in much the same

way that automobiles produced by different automobile manufacturers look rather alike, or like many paperback books designed for the airport trade look rather alike because they have the same page dimensions and the same style of cover—laminated paper with the name of book and author in raised letters. Unabridged dictionaries, board-page books for infants, travel books, encyclopedias, atlases, law books, and comic books are other examples of book genres that contain innumerable look-alikes published by different publishers, look-alikes that do not, however, confuse consumers about the identity of the publisher of any particular book.

We don't wish to seem wise after the event; someone had to be the first to think up the combination of oilcloth cover, large pages, and gilded edges, and for all we know that was PIL. But to reiterate the theme of this opinion, trademark and trade dress law do not protect originality; they protect signifiers of source. Publishers who want to distinguish their look-alikes from their competitors'—who want, that is, to make their trade dress identify the publisher—can easily do so by adopting a distinctive logo, imposing a uniform design, typeface, or color on the covers of their books, printing their name prominently on the covers, or doing all these things, as Penguin does. PIL does none of these things. It's its own fault if someone casually picking up a cookbook published by PIL and a cookbook published by Landoll thinks they were published by the same company; but it is more likely that the consumer would merely think the two books the same *type* of cookbook.

We have said nothing as yet about PIL's children's books. They are similar to the cookbooks, except that the pages are smaller (8½ by 8½) and the books shorter. The pages have gilded edges and the covers an oilcloth feel. But all three features (page size, gilding, and cover texture) are functional for children's books as for cookbooks. Children need large print, hence large pages, and they

like large pictures more than small ones (and large pictures require large pages); in some children's books the color pictures would bleed to the margin if the ends of the pages weren't uniformly colored; children frequently have dirty hands that stain everything they touch; and children love gold. PIL's children's books look like generic children's books rather than like the books of a particular publisher. They do not have a uniform series title (like "Golden Books"), the covers do not have uniform colors or designs, and the publisher's name is not prominently displayed. They are no more distinctive than the cookbooks.

Because the district judge found, correctly in our judgment, that PIL's books are not distinctive, he didn't reach the question whether Landoll's books are so similar as to be likely to confuse consumers. But as the ultimate issue in a trademark or trade dress case is likelihood of confusion, we were struck by PIL's failure to include in its appendix to either its main brief in this court, or its reply brief, photographs either of any of its own books or any of the books of Landoll that it claims are infringing its trade dress. In intellectual property cases, a picture, or, better, the very object claimed to infringe, is worth a thousand words of brief. Because Landoll's books resemble PIL's quite closely, as shown in the next photograph, PIL might have gotten some forensic mileage out of showing us the publishers' books juxtaposed. But the resemblance is generic, rather than specific. PIL's trade dress is not distinctive enough that its look-alikes would fool consumers.

AFFIRMED.

America's Best
C·O·O·K·I·N·G
[Landoll]

45 U.S.P.Q.2d 1277
(Cite as: 1997 WL 769349 (N.D.Ill.))

PUBLICATIONS INTERNATIONAL, LTD.,
an Illinois corporation, Plaintiff,

v.

LANDOLL, INC., an Ohio corporation, Defendant.

No. 96 C 5180.

United States District Court, N.D. Illinois.

Dec. 5, 1997.

MEMORANDUM OPINION AND ORDER

COAR, District J.

*1 Before the court is defendant Landoll, Inc.'s ("Landoll" or "defendant") motion for summary judgment of noninfringement as to all counts of plaintiff Publications International, Ltd.'s ("PIL" or "plaintiff") complaint, which alleges trade dress infringement of plaintiff's books under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), unfair methods of competition and unfair or deceptive acts or practices under the Illinois Consumer Fraud and Deceptive Business Practices Act, 815 ILCS 505/2, and deceptive trade practices under the Illinois Uniform Deceptive Trade Act, 815 ILCS 510/2(8). For the reasons set forth in this memorandum opinion, the defendant's motion is GRANTED and judgment is entered for the defendant on count one.

I. Facts

Can you judge a book by its cover? Plaintiff PIL says that you can—where that cover is glossy and padded,

on a cookbook or children's book with gold-colored, gilded pages and of a certain length, you can (and will) judge that that book is a PIL book. Once upon a time (1993), in the State of Illinois, PIL, a publisher offering books in several different areas, first began to sell cookbooks with certain characteristics: a uniform trim size of 8.5" by 11"; a length of 608 pages with gilded, gold-colored edges; glossy, padded covers; and printed in four colors. (Dft's 12(M) Stmt. ¶¶ 42, 9; Ptf's 12(N) Stmt., ¶ 1, 9.) PIL's cookbooks sold well, selling 2,702,171 copies of various cookbooks from 1993 to February 17, 1997. (Dft's 12(M) Stmt. ¶ 46.) In 1994, PIL began to sell children's books with certain characteristics: titles beginning "Treasury of . . ."; a uniform trim size of 9" by 9"; a length of 384 pages with gilded, gold-colored edges; glossy, padded covers; and printed in four colors. (Dft's 12(M) Stmt. ¶¶ 43, 10.) From 1994 to February 17, 1997, PIL sold 2,323,232 children's books, all incorporating these same characteristics. (Dft's 12(M) Stmt. ¶ 47.) All in all, PIL has published 17 different books (8 cookbooks and 9 children's books) incorporating the alleged trade dress. (Dft's 12(M) Stmt. ¶ 45.)

Gilded pages are readily available to all publishers through such printers as R.R. Donnelly & Sons ("Donnelly"), the printer for both PIL and Landoll. (Dft's 12(M) Stmt. ¶ 16.) Gilded pages can serve a number of purposes for books: masking a "bleed," where pictures and photographs which extend to the edges of a page present an uneven and unattractive series of different colored stripes on the edges; adding to the quality, aesthetic appeal, and attractiveness of books; creating a more deluxe, upscale, and ornamental book; increas-

ing the price-point of a book; adding to the perceived value of a book; and contributing to the commercial success of books. (Dft's 12(M) Stmt. ¶¶ 19, 24-27.) Padded covers are readily available to all publishers through printers, such as Donnelly, and have been used by publishers since at least 1986 or 1987. (Dft's 12(M) Stmt. ¶ 20.) Padded covers can serve a number of purposes for books: adding to the quality, aesthetic appeal, and attractiveness of books; creating a more deluxe, upscale, and ornamental book; increasing the price-point of a book; adding to the perceived value of a book; and contributing to the commercial success of books. (Dft's 12(M) Stmt. ¶¶ 24-27.) Third party publishers use gilded pages; third party publishers also use padded covers in a variety of markets. (Dft's 12(M) Stmt. ¶¶ 18, 22.) Some third party publishers use the combination of gilded pages and padded covers on their books but, for purposes of this motion, Landoll admits that it knows of no third party publishers using that combination with cookbooks or children's books. (Dft's 12(M) Stmt. ¶ 28; Dft's 12(M) Reply ¶ 28.) Donnelly salesman Jack Field has stated that gilded pages and padded covers tend to be used in "predominantly the same types of markets," i.e., where aesthetics were important for selling books. (Dft's 12(M) Stmt. ¶ 28.) Trim size tends to be depend in part on the size of the film to be included in the book, and the trim size used by PIL for its cookbooks, 8.5" by 11", is a common size for books and is economical and cost-effective. (Dft's 12(M) Stmt. ¶¶ 29-30, 33.) Cost and the ultimate price-point for a book are related to the trim size used. (Dft's 12(M) Stmt. ¶ 32.) Similarly, the number of pages contained in a book affects the perceived value of the book

by the consumer. (Dft's 12(M) ¶ 35.) Four color printing is a common practice in publishing. (Dft's 12(M) ¶ 36.) "Treasury of . . ." is a term which is a "consumer friendly" way of saying either compilation or treasury within one book. (Dft's 12(M) ¶ 37.) The term "treasury of . . ." is part of the title or subtitle on at least 346 different books published in the United States or exclusively distributed in the United States and which are currently or soon to be available in the near future. (Dft's 12(M) ¶ 38.) As Donnelly salesman Field has stated, the features alleged as trade dress by PIL "can be used in any number of combinations and it's really dictated by the publisher." Other features which could be used to increase attractiveness or appeal of books include ribbon markers, onlay, foil stamping, or a leather cover. (Dft's 12(M) ¶¶ 39-40.)

*2 One means of selling PIL's cookbooks and children's books was through display marketing, which is a marketing technique where products are marketed to ultimate consumers by being left at locations, such as schools or businesses, for several days to allow employees to inspect and then order the merchandise. (Dft's 12(M) Stmt. § G, especially ¶ 55.) Cookbooks and children's books are particularly well suited to be sold through display marketing, and books which have a higher perceived value, through such features as a padded cover, glossiness, gilded pages, and a heavier weight of the book, are quite appropriate for display marketing. (Dft's 12(M) Stmt. ¶¶ 57-58.) Thus, cookbooks with padded covers and gilded pages are successfully sold through display marketing. In fact, cookbooks sold through display marketing without padded covers or gilded pages have a lower price point and sell "'[n]ot

nearly as well'" as books having padded covers and gilded pages. (Dft's 12(M) Stmt. ¶ 56, 60.) In short, to sell cookbooks at the higher price point of $20 to $25, a company must provide a product with features, such as "'padding, gilding, and high page count'" which indicate higher value. (Dft's 12(M) Stmt. ¶ 61.)

In 1992, the owner of PIL, Louis Weber ("Weber") formed his own display marketing company; in fall 1994, PIL ceased selling all book products, including the subject books with padded covers and gilded pages, to third party display marketing companies in the United States. (Dft's 12(M) Stmt. ¶¶ 62-64.) Two reasons given by PIL executives for this decision are that PIL sought to use Weber's company as its "distributor of choice" in display marketing areas and that PIL did not want to "fund[ ] the competition." (Dft's 12(M) Stmt. ¶ 65.)

This lawsuit has occurred because of what happened next in the story. Certain customers, including display marketing companies, informed Landoll that they wanted books having features which made books more expensive-looking and increased the books' value or the perceived value. (Dft's 12(M) ¶ 14.) Landoll, seeking to "go more upscale" and enter into different, higher price-point markets, began to publish cookbooks and children's books using PIL's alleged trade dress: namely, cookbooks which are 8.5" by 11", contain varying numbers of pages[1] with gold-colored gilded pages, with

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[1] The two parties dispute the similarity in the number of pages in Landoll's books as compared to the (uniform) number of pages in PIL's books. For the purposes of this motion, which

(continued...)

glossy, padded covers, and printed in four colors and children's books which are 9" by 9", containing varying numbers of pages with gold-colored gilded edges, with glossy, padded covers, with subtitles utilizing the term "Treasury of . . .", and printed in four colors. (Dft's 12(M) ¶¶ 11-13.) Landoll first began to publish books with these combinations of features in 1995. (Dft's 12(M) ¶ 44.)[2]

II. Summary judgment standards

Summary judgment is proper "if the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there

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[1] (...continued)
deals with the distinctiveness of the alleged trade dress rather than the likelihood of confusion between Landoll's and PIL's books, the court notes merely that the books are of similar lengths.

[2] The parties include a number of facts which ultimately are not material to this particular motion, including facts put forward by Landoll regarding the lack of secondary meaning for the alleged trade dress and facts put forward by PIL regarding the intent of the two parties and regarding the likelihood of confusion. PIL does not argue that its trade dress has achieved secondary meaning but states that PIL "need not prove secondary meaning." (Ptf's Response, p. 13-14.) As discussed below in this opinion, the intent of the parties is not relevant; under the Lanham Act, Landoll is free to raid a non-distinctive trade dress without secondary meaning, and PIL's alleged intent to create a unique trade dress does not make a non-distinctive trade dress inherently distinctive. Finally, the likelihood of confusion is not at issue in this motion; Landoll's motion sought summary judgment solely on the issues of distinctiveness and functionality of the alleged trade dress—not on the likelihood of confusion.

is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); Cox v. Acme Health Serv., Inc., 55 F.3d 1304, 1308 (7th Cir.1995). A genuine issue of material fact exists for trial when, in viewing the record and all reasonable inferences drawn from it in a light most favorable to the non-movant, a reasonable jury could return a verdict for the non-movant. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986); Hedberg v. Indiana Bell Tel. Co., 47 F.3d 928, 931 (7th Cir.1995). The movant has the burden of establishing that there is no genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S.Ct. 2548, 2553, 91 L.Ed.2d 202 (1986); Hedberg v. Indiana Bell Tel. Co., 47 F.3d 928, 931 (7th Cir.1995). If the movant meets this burden, the non-movant must set forth specific facts that demonstrate the existence of a genuine issue for trial. Fed.R.Civ.P. 56(e); Celotex, 477 U.S. at 324, 106 S.Ct. at 2553. Rule 56(c) mandates the entry of summary judgment against a party "who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and in which that party will bear the burden of proof at trial." Celotex, 477 U.S. at 322, 106 S.Ct. at 2552-53. As a general rule, a scintilla of evidence in support of the non-movant's position is not sufficient to oppose successfully a summary judgment motion; "there must be evidence on which the jury could reasonably find for the [non-movant]." Anderson, 477 U.S. at 250, 106 S.Ct. at 2511.

III. Lanham Act Analysis

*3 This case involves a relatively new question in trade dress: trade dress protection of product configuration. The parties failed to come to grips with—or even to acknowledge—the body of law dealing with the specific question, as opposed to the body of law dealing with general trade dress issues. While the general cases are not irrelevant to the issue at hand, they are not helpful in answering the question of whether PIL's product configuration merits protection as inherently distinctive trade dress. As this section demonstrates, PIL's product configuration does not merit such protection.

Trade dress "encompasses the overall appearance of a product including its size, color or color combinations, texture graphics, packaging or other visual features." Roulo v. Russ Berrie & Co., Inc., 886 F.2d 931, 936 (7th Cir.1989), cert. denied, 493 U.S. 1075, 110 S.Ct. 1124, 107 L.Ed.2d 1030 (1990). "An infringement of the trade dress is proven if: (1) the plaintiff's trade dress is inherently distinctive or has acquired secondary meaning, (2) the plaintiff's trade dress is primarily non-functional, and (3) the defendant's trade dress is confusingly similar, engendering a likelihood of confusion in the marketplace." Id. at 935. The plaintiff has the burden of proof to show that prongs one and three are met, while the defendant has the burden of proof to show that prong two has not been met (i.e., that the trade dress is primarily functional). Computer Care v. Service Systems Enterprises, Inc., 982 F.2d 1063, 1067-68 (7th Cir.1992). In this motion, Landoll argues that PIL has failed to meet its burden of proof on prong 1 and that Landoll has met its burden of proof on prong three.

PIL seeks to meet its burden on prong one by showing that its trade dress is inherently distinctive. PIL is correct when it states that it need not show secondary meaning in the market, that consumers actually link the product with PIL, for proof that a product's trade dress is distinctive is sufficient in and of itself, where PIL successfully shows that the trade dress is inherently distinctive. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 773, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992); Roulo, 886 F.2d at 937; Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir.1986); Chevron Chemical Co. v. Voluntary Purchasing Group, 659 F.2d 695, 702 (5th Cir.1981). But what PIL seeks to protect as inherently distinctive trade dress is its product configuration: the various parts that make up a book: cover, pages, trim size, heft, and, with the children's books, the term "Treasury of . . ." in the title. As the Seventh Circuit has stated, "[t]rade dress protection in the configuration of the product itself opens up another can of worms." Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 657 (7th Cir.1995), cert. denied, ___ U.S. ___, 116 S.Ct. 1044, 134 L.Ed.2d 191 (1996). Trade dress is only protected insofar as the trade dress serves as a "signifier of source"; where the "trade dress" at issue is a product configuration, there is a risk that protecting the trade dress will prevent competitors "from duplicating features whose value to consumers is intrinsic and not exclusively as a signifier of source," thus injuring competition and preventing copying which is beneficial to consumers. Id. at 657. In short, a court considering a trade dress infringement action dealing with product configuration must consider "whether a product feature's primary significance to

consumers is as an identifier of source or as an element which contributes to the inherent appeal of the product." Id. at 658.

*4 The question remains: what standard to apply to determine whether a product configuration is inherently distinctive? One possibility is to use the so-called Abercrombie taxonomy of marks, which categorizes marks in "categories of generally increasing distinctiveness . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." Taco Cabana, 505 U.S. at 768, 112 S.Ct. at 2757 (citing Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2nd Cir.1976). PIL argues that this taxonomy should apply to its trade dress and, moreover, argues that because the design of the books is "only tenuously connected with the nature of the content of those books," that design is arbitrary or fanciful or, at most, suggestive. (Ptf's Resp. at 5.) This argument misses the point. The design of the books is part of the books—not something that is in relation to the books. See Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431, 1440-41 (3rd Cir.1994) ("[A] product configuration differs fundamentally from a product's trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product). Being constitutive of the product itself and thus having no such dialectical relationship to the product, the product's configuration cannot be said to be 'suggestive' or 'descriptive' of the product, or 'arbitrary' or 'fanciful' in relation to it."). See also Thomas & Betts, 65 F.3d at 658 ("The issue is slightly different in most trade dress product configuration cases, because product features, though they may iden-

tify the source of the product, do not really identify the product—they are the product.") (citing Duraco); Knitwaves, Inc. v. Lollytogs Ltd. (Inc.), 71 F.3d 996, 1007-08 (2nd Cir.1995) (rejecting application of Abercrombie taxonomy to product configuration; stating that the classification of marks into 'generic,' 'descriptive,' 'suggestive,' or 'arbitrary or fanciful' make[s] little sense when applied to product features"; stating that "'arbitrary,' 'fanciful,' or 'suggestive' packaging of a product may be presumed to serve this source-identifying function" but that "the same presumption may not be made with regard to product features or designs whose primary purposes are likely to be functional or aesthetic."); Sassafras Enterprises, Inc. v. Roshco, Inc., 915 F.Supp. 1, 4 n. 4 (N.D.Ill.1996) (stating that the Abercrombie "taxonomy really does not help much when the appearance of the product itself is at issue").[3] But see Stuart Hall Co., Inc. v. Ampad Corp., 51 F.3d 780, 788 (8th Cir.1995) (rejecting distinction between product configuration and product packaging; rejecting Duraco reasoning or test).

Beyond the irrelevance of the Abercrombie taxonomy of distinctiveness as applied to product configuration, application of the Abercrombie taxonomy to product features runs the risk of providing trade dress protection into the indefinite future for features which, while unique to the product at issue, are not source-identi-

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[3] Cf. University of Georgia Athletic Assoc. v. Laite, which clearly demonstrates that the Abercrombie taxonomy is used to show a relationship between a mark (there, the "University of Georgia" mascot) and the product (there, the University of Georgia athletic teams). 756 F.2d 1535, 1540-41 & n. 16 (11th Cir.1985).

fying. Here, PIL argues that because the books' features "convey nothing about the contents" of the books and asserts (without support) that "[v]irtually no one purchases a book simply because it looks good on the outside. If the contents do not deliver, there will be no sale, unless, of course, the consumer believes it to be a book published by a publisher with whose trade dress he or she has become familiar, and with whose products he or she has been satisfied in the past."[4] (Ptf's Resp. at 5.) But this argument shows the inherent danger of applying the Abercrombie taxonomy to product configuration. The undisputed facts show that the alleged

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[4] PIL also errs in this statement by confusing and melding the "inherently distinctive" test and the "secondary meaning" test. "To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851 n. 11, 102 S.Ct. 2182, 2187 n. 11, 72 L.Ed.2d 606 (1982). See also Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 164, 115 S.Ct. 1300, 1303, 131 L.Ed.2d 248 (1995) (citing Inwood Labs definition of "secondary meaning"); Thomas & Betts, 65 F.3d at 658 (same); Sassafras Enterprises, Inc. v. Roshco, Inc., 915 F.Supp. 1, 6 (N.D.Ill.1996) (same). Thus, PIL's argument regarding whether a consumer buys its books because they look and feel good or because he or she associates them with "a publisher [i.e., PIL] with those trade dress he or she has become familiar", (Ptf's Resp. at 5 (emph.added)), goes to the question not of whether the trade dress is inherently distinctive but whether the product's features have acquired secondary meaning in the minds of the public, i.e., that consumers seek to purchase the product not for its "inherent appeal" but because they "desire the product with the particular feature because it signifies that producer." Thomas & Betts, 65 F.3d 658-59 (discussing secondary meaning in product configuration case). PIL has offered neither evidence nor argument supporting such a secondary meaning claim.

trade dress at issue is made up entirely of features which contribute to the price-point, salability, and aesthetics of the books, but, under PIL's view of the trade dress world, the fact that PIL did not have to use those features and was the first to decide that the particular combination of features would be an effective way of selling books means that PIL should presumptively have perpetual protection of that combination. That is simply not the case.[5]

*5 If the Abercrombie taxonomy does not apply to product configuration cases, what is the applicable standard? There are several options. The first, the Chevron test, states that a trade dress is inherently distinctive "[i]f the features of the trade dress sought to be protected are arbitrary and serve no function either to describe the product or assist in its effective packaging." 659 F.2d at 702. As stated in this court's opinion in Nelson/Weather-Rite Inc. v. Leatherman Tool Group, Inc., 1995 WL 669091, *8 (N.D.Ill.1995), and in accordance with the discussion above regarding the Abercrombie taxonomy, the court finds that the Chevron test is inapplicable when dealing with product configuration as opposed to the "packaging" of a product. The second option is the Seabrook Foods, Inc. v. Bar-Well Foods, Ltd. test which requires a determination of: (1) whether a trade dress is a common, basic shape or design; (2) whether it is unique or unusual in its particular field; (3) whether it is a mere refinement of a com-

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[5] This holding does not contradict Taco Cabana, as PIL suggests in its Response. Taco Cabana operated under the assumption that Taco Cabana's trade dress was not descriptive, was inherently distinctive, and was not functional. 505 U.S. at 770, 112 S.Ct. at 2758.

monly-adopted and well-known form of ornamentation for a particular class of goods which consumers view as mere ornamentation. 568 F.2d 1342, 1344 (C.C.P.A. 1977). "In reality, all three questions are merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin—a trademark." 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 8.13 (4th ed.1997). The McCarthy restatement of the Seabrook test has been cited by two recent cases in this district as the appropriate overall principle by which to judge inherent distinctiveness in product configuration trade dress cases. See Artipresent GmbH Vertrieb Internationaler Collectionen fur den Wohnbereich v. Emruss Corp., 1997 WL 534358, *2 (N.D.Ill.1997); Sassafras, 915 F.Supp. at 5 (using McCarthy restatement of the Seabrook test as the standard by which to judge the inherent distinctiveness of a trade dress in a product configuration case). This is the approach which this court will apply.[6]

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[6] The court in Thomas & Betts cited with approval the Third Circuit's discussion in Duraco of inherent distinctiveness in product configuration case. 65 F.3d at 658 n. 3. In Duraco, the Third Circuit, in addition to discussing the complexities and special context of product configuration cases, adopted a three-element test for inherent distinctiveness in product configuration cases: to be inherently distinctive, and thus protected as trade dress without need to show secondary meaning, a product configuration must be "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of the product." 40 F.3d at 1448. The Second Circuit has accepted Duraco's discussion of the context

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In applying the Seabrook/Sassafras test to PIL's alleged trade dress, the court finds that PIL's alleged trade dress is not sufficiently "unique, unusual or unexpected" in the book market to "automatically be perceived . . . as an indicator of origin" because it is merely a refinement of existing ornamentation. Here, every element in the alleged trade dress serves a function—namely, of making the overall product more desirable to consumers as a "deluxe" product and, thus, enabling the same of the overall product with a higher price-point. No Seventh Circuit case has ever held that a product configuration consisting completely of functional elements can be inherently distinctive. Cf. Elmer v. Ice Fabricating, Inc., 67 F.3d 1571, 1579-80 (Fed.Cir. 1995) (noting that, while the Eleventh Circuit may find that a product including some functional features is inherently distinctive, "the Eleventh Circuit has not held protectable a trade dress that encompassed only useful product features"). Additionally, every element included in the product configuration is common to the book industry—and, thus, even though it puts together these elements in a "new" combination, the trade dress overall is not unique. See Turtle Wax, Inc. v. First Brands Corp., 781 F.Supp. 1314, 1320-21 (refusing to find inherent distinctiveness in "new" combination of

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[6] (...continued)
of product configuration cases while reject the first two elements of Duraco's test as "not rooted in the language of the Lanham Act." Knitwaves, 71 F.3d at 1008 & n. 6. The court in this case does not need to determine whether the test for inherent distinctiveness in product configuration cases should include the first two Duraco elements because PIL has failed to meet the third element, which is essentially the same as the Seabrook/Sassafras test.

elements where "no single component of the . . . trade dress . . . truly is unique to that product"; "The Court cannot agree with Turtle Wax that a finding of inherent distinctiveness was required simply because no existing product utilized precisely the same combination of elements as plaintiff's . . . trade dress."). In a market where these elements are used by third party publishers to create a higher perceived value for their books, there is no reason to believe that consumers should perceive the particular combination of elements as anything more than a refinement of ornamentation raising the perceived value of the books.

*6 PIL points to several cases where product lines were deemed inherently distinctive. None are analogous. The three relevant product lines discussed by PIL are greeting cards/stationery, furniture, and books. Of the three greeting cards/stationery cases, one, Hartford House, Inc. v. Hallmark Cards, Inc., involved a product line that the district court found "had acquired a secondary meaning"; the case does not discuss whether the cards could have been protected as inherently distinctive. 846 F.2d 1268, 1272 (10th Cir.), cert. denied, 488 U.S. 908, 109 S.Ct. 260, 102 L.Ed.2d 248 (1988). The second case, Roulo, involved a card design which a third-party card curator testified was so unique that to her knowledge no other card in that century had used it. 886 F.2d at 936. There was also testimony from the defendant that the plaintiff's cards "were as unusual as those of . . . other famous card designers." Id. The third case deals with product packaging using "bold colors and a graduated color fade with knock-out graphics and other artwork on the package"; the court found that the "unique use of colors and graphics creates a distinctive

visual impression in the minds of consumers." Lisa Frank, Inc. v. Impact International, Inc., 799 F.Supp. 980, 989 (D.Ariz.1992). Beyond the fact that these cases are dealing with the law pre-Taco Cabana, Duraco, and Thomas & Betts,[7] each case involves an item whose overall look was a distinct, artistic impression, and, thus, collectively do not dictate that a combination of features which "is merely a refinement of existing forms of ornamentation" should be protected by the Lanham Act. See Turtle Wax, 781 F.Supp. at 1321-22 (distinguishing Roulo). The second line of cases at issue involved furniture. The Federal Circuit in Imagineering, Inc. v. Van Klessens, Inc. upheld a jury's finding that a particular line of furniture was inherently distinctive where the plaintiffs had offered evidence of media accounts calling the furniture line "'novel,' 'exclusive,' and 'outdoor classics,' and testimony from witnesses that the line "was unlike any other furniture yet produced." 53 F.3d 1260, 1264 (Fed.Cir.1995), cert. denied, ___ U.S. ___, 116 S.Ct. 277, 133 L.Ed.2d 197 (1995). One of the other cases on which PIL relies not only did not hold that the furniture line in question was inherently distinctive, but that holding of no inherent distinctiveness was affirmed in the appellate court vacating a preliminary injunction on the grounds that the plaintiff likely could not show secondary meaning. L. &

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[7] The latest case dealing with the design of greeting cards found that a greeting card design featuring die cut images of animals, people, or objects was not inherently distinctive as it was merely "a refinement on the die-cut greeting card design" despite "its initial novelty within the greeting card industry." Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 59 F.3d 27, 33 (2nd Cir.1995).

J.G. Stickley, Inc. v. Canal Dover Furniture Co., Inc., 79 F.3d 258, 262-63 (2nd Cir.1996). Cf. Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381-82 (2nd Cir.1997) (rejecting claim of inherent distinctiveness for product configuration of furniture line where plaintiff failed to detail what the unique combination of features involved was; noting caution where plaintiff seeks to protect an "array of products"). The third product line, books, would seem to be the most relevant, but none of these cases are good analogies to PIL's situation because none address the issue of inherent distinctiveness; instead, the cases either focus solely on likelihood of confusion, see, e.g., Simon & Schuster v. The Putnam Berkley Group, Inc., 1994 WL 689058 (S.D.N.Y.1994), or find secondary meaning and likelihood of confusion, see, e.g., Harlequin Enterprises Ltd. v. Gulf & Western Corp., 644 F.2d 946 (2nd Cir.1981); Time Inc. Magazine Co. v. Globe Communications Corp., 712 F.Supp. 1103 (S.D.N.Y.1989), or find that a trademarked cover design was strong and had acquired customer identification, in addition to likelihood of confusion. Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc., 718 F.Supp. 1159, vacated on other grounds, 886 F.2d 490 (2nd Cir.1989).[8]

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[8] This line of cases also raises an additional problem with PIL's claims. The books at issue in Harlequin share almost all characteristics: (1) glossy white covers; (2) identical dimensions in height, width and thickness; (3) placement of series' number and price in similar type in the same place on the covers; (4) price; (5) collage of gold filigree with publisher's colophon (one a black and white harlequin framed by a gold diamond, one black silhouettes of a man and woman framed by a gold oval) on same place on the covers; (6) series' titles

(continued...)

*7 No reasonable jury could find that PIL's product configuration is inherently distinctive. The court also notes its reluctance to extend trade dress protection to product configurations involving such common elements, all of which serve to increase the price-point and aesthetics of the products and, hence, to increase the intrinsic desirability of the products. PIL's claims, if accepted, would use "trade dress protection [to] undermine restrictions in copyright and patent law that are

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[8] (...continued)
printed in similar black script with one word of the series' title appearing on each side of the colophon; (7) author's name printed in bold, colored capital letters under the collage; (8) book's title printed below the author's name on both books in black lettering; (9) bottom half of each cover being an illustration of a man and a woman in a romantic setting suggesting the book's story line. 644 F.2d at 949. Thus, the books involved in the trade dress infringement action involved more than just similar size, gloss, and even color on their covers—every element was similar. By contrast, PIL does not attempt to claim that its books and Landoll's books share similar typefont, use of trademarks, illustration, or title placement. Even more striking is Roulo, where the court actually found inherent distinctiveness. There, virtually every element was similar: (1) identically sized; (2) identical price; (3) single-faced (as opposed to imprinted on two or more faces); (4) on beige or cream-colored textured paper; (5) featuring handwritten messages; (6) written in brown ink; (7) using ellipses in the message; (8) flanking the messages with multiple colored stripes; (9) displayed identically in a four-sided, 32-card rack with each side displaying a single color scheme. 886 F.2d at 935, 937. The only distinction was that only the plaintiff's card used a foil stripe in its flanking stripes and only the defendant's card used a colored foil butterfly superimposed on the flanking stripes. Id. There, plaintiff had used these nine elements to produce a specific artistic impression and did not, like PIL does in this case, attempt to base a claim of inherent distinctiveness merely on the size and medium (in Roulo, textured paper) used.

designed to avoid monopolization of products and ideas." Jeffrey Milstein, 58 F.3d at 32. If every time a product is introduced into the market including some "new" combination of features, the product received trade dress protection—regardless of a lack of distinctiveness in the product—"competition would be hindered." Thomas & Betts, 65 F.3d at 657; Turtle Wax, 781 F.Supp. at 1321. The ability to copy product features which are intrinsically valuable to consumers "is not only good, it is a federal right—a necessary component tc the patent system's grant of limited monopolies." Thomas & Betts, 65 F.3d at 657. This court is unwilling to extend trade dress protection as far as PIL needs it to go in order to protect PIL's product configuration: namely, to protect any new combination of features.[9]

Thus, Landoll's summary judgment motion is granted as to count one of PIL's complaint (Lanham Act trade dress infringement). While Landoll labeled its motion as one for summary judgment "as to all counts of the

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[9] The context of this particular case highlights the uneasy relationship between competition and trade dress protection. Here, the trade dress at issue is one which is good for display marketing. PIL has decided to pull its products from other display marketers in order to utilize its own display marketing company. But when the other display marketing companies arranged for another company to offer a competing product utilizing the features from PIL's books which make them good for display marketing, PIL sought to use trade dress protection to prevent Landoll's production of the books—which also would prevent PIL's competition in the display marketing area from offering a competing product. If precedents in the trade dress case law justified PIL's claims, the court would, of course, uphold its rights, but the court will not stretch the case law to effect this result.

complaint," neither side addressed the two state law counts and the court will not rule on the other counts without such argumentation by the parties.

IV. Functionality

Landoll also argues that PIL's product configuration is functional. The court will not rule on this issue, as PIL has failed to show that its trade dress either is inherently distinctive or has secondary meaning. The court will note, however, that Landoll's argument confuses "functional" in this area for "useful." As discussed above, PIL's product configuration is made up entirely of "functional" elements, i.e., elements which are useful. But "functionality" as used in prong 3 of the test for trade dress infringement is a term of art, referring not to the usefulness per se of a particular trade dress but to the necessity of having that trade dress available because alternate trade dresses cannot achieve the same benefits and, thus, protection of the trade dress would cripple competition. Abbott Laboratories v. Mead Johnson & Co., 971 F.2d 6, 21 (7th Cir.1992) (defendant "must not only point to certain advantages [of a product design], but also demonstrate that depriving [defendant] of these advantages will have a materially adverse impact upon its ability to compete effectively" against the plaintiff). Thus, it is not enough that Landoll demonstrate that PIL's product configuration is advantageous, which Landoll clearly has shown. Landoll would also have to demonstrate that offering another product configuration would either be so costly as to affect price adversely or that consumers or retailers "so prefer [PIL's product configuration] that no other [con-

figuration] will do." Id. Landoll, on the record as it currently stands, has offered neither evidence nor argument tending to show that PIL's product configuration is functional under the Abbott Labs standard.

V. Conclusion

*8 Defendant Landoll's motion for summary judgment is GRANTED as to count one of PIL's complaint. The case remains OPEN with regard to counts two and three of PIL's complaint. The court will not address Landoll's motion to strike PIL's survey regarding likelihood of confusion at this time. The parties are directed to address by memorandum the relevance of the survey to the remaining state law counts. PIL shall submit a memorandum by December 9, 1997 addressing the relevance of the survey, and Landoll shall submit a responsive memorandum by December 16, 1997. The matter of the survey shall be taken up at the pretrial conference.